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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,135

06/08/2006

Dan Hashimshony

31380

8998

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7590

09/21/2011

MARTIN D. MOYNIHAN d/b/a PRTSI, INC.

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EXAMINER

DANEGA, RENEE A

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

09/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/582,135	HASHIMSHONY ET AL.	
	Examiner	Art Unit	
	RENEE DANEGA	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-51 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-6,8-11,14-16,18,22-29,32-35,38-40,47 and 50 is/are rejected.
- 8) ☒ Claim(s) 6, 19-21, 30-31, 41-46, 48-49, 51 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 18, 47, and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how with the addition of a lining to the structure the approach to the specimen at each face for entry for manipulation would not be limited by the structure.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4-6, 8-11, 14-16, 22-26, 28-29, 32-35, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman (US 6035808).

- Regarding claims 1 and 24, Herman teaches a device and method for tissue handling comprising providing a device comprising a structure configured for receiving and holding a tissue specimen wherein the specimen can include tissue positional references (36, neck enclosure); and at least one holder (29) (30) for holding the first outline frame (204) with the tissue specimen thus fixing the orientation (Figure 4) of the tissue specimen in a manner allowing a clear approach for manipulation of the specimen, the approach to the specimen at each face for entry for manipulating and fixing not being limited by said structure (Figure s 1, 3, 4); and device positional references (36) (56) (for fixing the orientation of the tissue specimen when held by the device (Figures 12-15).
- Regarding claims 2 and 26, Herman teaches the device configured to define tissue lateral and superior sides and a top face (Figures 2, 4)
- Regarding claim 4 and 28, Herman teaches a device capable of receiving tissue prior to its complete removal due to its open configuration (Figure 2).
- Regarding claim 5 and 29, Herman teaches device positional references are built into the structure of the device (36) (Figure 2).
- Regarding claims 8 and 32, Herman teaches the device is formed as a rigid body (Figure 2).
- Regarding claims 9-11, 14, 33-35, and 38, Herman teaches the device formed as an expansible body flexible stretchable body or resilient cage

(57 and equivalent structure at the rear of the specimen) (Figures 3 and 4).

- Regarding claims 15 and 39, Herman teaches the device formed as a box outline comprising a box outline body (204), lid, (202) and at least one holder (5) (35) (Figure 2).
- Regarding claims 16 and 40, Herman teaches the structure comprising first (29, 30) and second (20) frames designed to be superimposed and receive and hold the tissue there between and at least one holder (57) for holding first and second frames together thus fixing the orientation of the specimen (Figures 3-4).
- Regarding claims 22, Herman teaches the device further including handles (24) for holding the device).
- Regarding claim 23, Herman teaches the device provided in a plurality of sizes (Figure 3).
- Regarding claim 25, Herman teaches maintaining the specimen immobile in the device (Figure 4).

5. Claims 3 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross, Jr. et al. (US 5766173).

Regarding claims 3 and 27, Ross teaches a device and method for tissue handling comprising providing a device comprising a structure configured for receiving and holding a tissue specimen wherein the specimen can include tissue positional references (114, 116); and at least one holder (126a) for holding the first outline frame

(106) with the tissue specimen thus fixing the orientation (Figure 1) of the tissue specimen in a manner allowing a clear approach for manipulation of the specimen, the approach to the specimen at each face for entry for manipulating and fixing not being limited by said structure (Figure 1) and device positional references (116, 114) (for fixing the orientation of the tissue specimen when held by the device (Figures 1)). Ross further teaches the device is substantially transparent to at least one imaging modality selected from a group consisting of x-ray, gama, and MRI (column 2, line 55) (column 3, lines 10-15) (column 9, lines 1-10).

Allowable Subject Matter

6. Claims 6, 19-21, 30-31, 41-46, 48-49, 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments, with respect to the rejection(s) of the claims under Nagle have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Herman teaching a specimen holder that would still permit access by a handler at any surface. Even if it could be argued the side bars may inhibit access when tightened around the specimen, when left with clearance between the specimen and the cage, the specimen is still unable to shift position and there will be access via the clearance. Claims 3 and 37 are rejected with the incorporation of their parent claims under Ross, Jr. providing a substantial amount of plastic in the device.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RENEE DANEGA whose telephone number is (571)270-3639. The examiner can normally be reached on Monday through Thursday 8:30-5:00 eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RAD

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736